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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ian Eisenberg

2885

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7590

05/30/2007

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EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/815,368		EISENBERG, IAN	
	Examiner		Art Unit	
	Adam Levine		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9 February 2007</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment filed February 9, 2007, in response to the office action mailed November 28, 2006, was not entered because it was non-compliant. The amendment to the title was the source of the non-compliance and was re-filed on March 16, 2007, in compliant form. The amendments filed February 9, 2007, also included amendments to the claims and the drawings. These additional amendments were not re-filed with the amendment to the title, but it is assumed the applicant intends to include them with the current amended application.

The original application included claims 1-16. The amended claim listing indicates that claims 1-16 have been cancelled and new claims 17-36 have been filed in their stead. Claims 17-36 are therefore currently pending and considered in this office action.

Pertaining to objections to the drawings in the previous office action

The office action mailed November 28, 2006, included a "Notice of Draftsperson's Patent Drawing Review," PTO-948. (See paper # 20061115, form PTO-948). These objections have been addressed by the replacement drawings.

Pertaining to objections to the specification (title) in the previous office action

The disclosure was objected to because the title of the invention was not descriptive. The title has been amended and the new title is clearly indicative of the invention to which the claims are directed. The objection is withdrawn.

Pertaining to objections to the specification (copyright notice) in the prior office action

It appears that applicant attempted to delete the improper copyright notice in applicant's submission of February 9, 2007, however, the amendments to the specification were not entered because the specification amendment as a whole was held to be non-compliant. This amendment should therefore be resubmitted, taking care to ensure that it is submitted in compliant form.

Pertaining to other amendment to the specification

With regard to the other amendments to the specification submitted on February 9, 2007, amendments to the specification were not entered because the specification amendment was held to be non-compliant. Because the amendment to the title is the only specification amendment that has been resubmitted, the amendment of the title is the only specification amendment that has been entered. All other amendments to the specification should therefore be resubmitted, taking care to ensure that they are submitted in compliant form.

Pertaining to objections to the claims in the previous office action

All prior claims having been cancelled, all claim objections in the previous office action are moot.

Pertaining to rejections under 35 USC §§112, 101, 102, and 103 in the prior office action

All prior claims having been cancelled, all claim rejections in the previous office action are moot.

Response to Arguments

Applicant's arguments with respect to claims 1-16, filed February 9, 2007, have been fully considered but are moot in view of the cancellation of claims 1-16 and in view of the new ground(s) of rejection.

Information Disclosure Statement

The information disclosure statement filed February 9, 2007, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

A copyright notice appears at the bottom of the first page of the specification. This notice will not be permitted. A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the

following authorization language is included at the beginning (preferably as the first paragraph) of the specification. 37 CFR 1.71(d).

The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any-one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever. 37 CFR 1.71(e).

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the U.S. Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C) above does not include the specific language "(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181. See MPEP §608.01(v) II. Examiner notes here that it appears applicant is claiming the entire application as subject to the copyright of the applicant. This is not permissible as it is inconsistent with the above. Appropriate correction is required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 26 and 36 are objected to because of the following informalities: In line 21 and 2, respectively, "purchase" should be "purchaser." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 17-36 are rejected under 35 U.S.C. 112, first paragraph**, because the specification, while being enabling for "sending SMS message(s) to the would-be-purchaser containing a telephone number," does not reasonably provide enablement for "sending SMS message(s) to the would-be-purchaser containing a short code." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. This is due to the lack of description of "short code" anywhere in the specification, leading to the inability to distinguish between it and other codes or series of numbers that are described, such as telephone numbers and PIN codes.

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There is no way to distinguish what exactly the "short code" is intended to encompass, whether it would be comparable to or distinguished from telephone numbers or PIN codes, and what its consequent role would be in the invention.

2. **Claim 27 is rejected under 35 U.S.C. 112, first paragraph**, because the specification, while being enabling for "an automated SMS message handling system," does not reasonably provide enablement for "an automated telephone response system." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. It may be that the "automated telephone response system" encompasses the "automated SMS message handling system," however, based on the specification, there is no way to determine exactly what the "automated telephone response system" is intended to encompass, as it is not described anywhere in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 17-18, and 26 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 26 recite the limitation "the offer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the provider" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumar (US Pub.No.2002/0143634 A1).

Kumar teaches all the limitations of claims 17-19 and 21-36. For example, with regard to claims 17-19 and 21-25, Kumar discloses a method for conducting an offer, purchase, and supply of goods and/or services with a would-be-purchaser in possession of an SMS enabled phone. Kumar further discloses:

- engaging in a phone call with the would-be purchaser: offering through the call that the would-be-purchaser may accept an offer to purchase goods and/or services and receiving through the call acceptance of such offer (see at least abstract, page 1 ¶¶0002,0005; pages 3-4 ¶0035-0036);
- sending confirmation SMS message(s): to the would-be-purchaser's phone, SMS message(s) comprise some or all of: information regarding goods and/or services available for use for a first period of time and/or a period of time subsequent to the first period of time, terms of purchase, a fee schedule, a request for an

additional acceptance by the would-be-purchaser of the offer, sending confirmation SMS message(s) and SMS message(s) to the would-be-purchaser's phone further comprises sending such message(s) utilizing SMS message delivery confirmation (see at least figs.3E-3F, page 2 ¶¶0008,0019; page 4 ¶0041. Please note: The information present in the SMS message is descriptive material and is not functionally involved in the recited steps of the method.

Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106);

- receiving from the would-be-purchaser acceptance of the payment terms: relative to a sent SMS message (see at least abstract, figs.3B-3C,3E-3F; page 2 ¶¶0019-0021); the would-be-purchaser sending at least one reply to a sent confirmation SMS message with an indication of acceptance included in the body of the at least one reply SMS message (see at least abstract, figs.3E-3F; page 2 ¶¶0019-0021, page 4 ¶¶0036,0041; pages 5-6 ¶0051, page 6 ¶0060).
- sending SMS message(s) to the would-be-purchaser containing a short code and/or a telephone number: through which the would-be-purchaser may obtain the goods and/or services, terminating use of the short code or telephone number by the would-be-purchaser upon lapse of the then-extant period of time, sending to the would-be-purchaser an SMS message containing a PIN code, utilizing the PIN code to control access to the goods and/or services, associating

the PIN code with the period of time acquired by the would-be-purchaser and terminating the use of the short code and/or telephone number upon lapse of the period of time associated with the PIN code, sending the PIN code to a third party provider of the goods and/or services (see at least abstract, figs.3E-3G, page 1 ¶¶0003,0005; page 4 ¶0036, pages 5-6 ¶¶0034-0035. Please note: 'short code' is not described in the specification and has been interpreted as either a pin or a telephone number, a dichotomy that is now untenable given the distinction in function presented by this step. This distinction in function is unclear in the claims but is imputed by the examiner based on context for purposes of a thorough examination).

- receiving from a telecommunications service provider an amount: related to an amount billed by the telecommunications service provider to the would-be-purchaser for use of the short code and/or a specialty purpose telephone number (see at least fig.3A,3D; page 1 ¶0005); provider of the goods and/or services also performs a step of billing the would-be-purchaser according to the accepted payment terms (see at least abstract, page 1 ¶0002, page 4 ¶¶0040-0042).

Pertaining to system claims 26-34 and 36

Rejection of system claims 26-34 and 36 is based on the same rationale as noted above. In addition, Kumar discloses:

- a component: to engage in a phone call, determine the phone number of the would-be-purchaser, send SMS message(s) using SMS message delivery confirmation, receive from a telecommunications service provider an amount, bill

the would-be-purchaser according to the accepted offer, terminate use of the short code or telephone number, control access to the goods and/or services, associate the PIN code with the period of time, generate a PIN code (see at least abstract, figs. 1-2, 3B, 4; page 1 ¶¶0002-0006, page 2 ¶¶0008-0012, 0023-0024); an automated telephone response system, an automated SMS message handling system (see at least abstract, figs. 1-3, page 2 ¶0008, page 3 ¶0034)

- an SMS enabled phone: (see at least fig. 2, page 3 ¶0033).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar in view of Official Notice (regarding duplication of parts).

Kumar teaches all of the above as noted under the 102(b) rejection and teaches a) ordering goods or services, b) ordering services via SMS enabled mobile telephone, and c) services delivered via SMS enabled mobile telephone, but does not disclose sending subsequent confirmation SMS message(s) to obtain additional acceptance relative to a period of time subsequent to the first period of time (Please note: this is interpreted as repeating the steps required for the initial purchase in order to purchase additional allotments). The examiner takes the position that it would have been obvious

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to one having ordinary skill in the art at the time the invention was made to include sending subsequent confirmation SMS message(s) to obtain additional acceptance relative to a period of time subsequent to the first period of time, since it has been held that mere duplication of essential parts involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 17-36 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-16 of copending Application No. 11/089843. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A method for purchase of goods and/or services comprising a phone call between a would-be purchaser and a service provider/vendor, a text or multimedia message being forwarded to the would-be purchaser's mobile phone device relating to purchase of services and/or goods, or purchase options and/or terms of procuring services and/or goods, and upon acceptance of the contents of the text or multimedia message, the would-be purchaser or caller is billed or charged a fee which allows the caller's access to telephonic and/or Internet vendor provided services and/or goods for a first determined time period.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
May 24, 2007


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